

Attorney Docket No. 08048.0021-00000

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jean DE RIGAL et al.

Application No.: 10/006,886

Filed: December 10, 2001

For: A COMPARISON SAMPLE FOR
SIMULATING THE COLOR OF
KERATINOUS ELEMENTS, AND
RELATED METHODS

Group Art Unit: 1631

Examiner: M. Allen

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action dated April 30, 2003, the Examiner required restriction under 35 U.S.C. § 121 between the following claim groupings:

Group I, claims 1-105;

Group II, claims 106-137;

Group III, claims 138-141;

Group IV, claims 142-164;

Group V, claims 165-187;

Group VI, claims 188-199;

Group VII, claims 200-212; and

Group VIII, claims 213-219.

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In the Office Action, the Examiner asserts that these claim groupings are distinct from one another because 1) with respect to Groups I and II, "the product of Invention I is not required to be produced by the method of Invention II and the product as claimed can be made by a materially different process"; 2) regarding Groups I and (III-VII), they "are related as product and process of use" and "Invention I can be used in multiple methods"; 3) regarding Groups I and VIII, the method of Invention VIII does not use the product of Invention I"; and 4) regarding Groups II-VIII, "they have different starting materials, method steps, and/or goals." Office Action at 2. Applicants respectfully disagree with the restriction requirement and respectfully request that the Examiner modify this requirement so that Applicants will be able to elect either 1) Group I, claims 114-137 of Group II, and Groups III-V and VII, together, or 2) claims 106-113 of Group II, and Groups VI and VIII, together.

Applicants respectfully submit that the restriction requirement between Group I, claims 114-137 of Group II, Groups III-V and VII should be withdrawn because it would not constitute a burden to search the subject matter of those Groups together. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. § 803 (emphasis added).

Applicants respectfully submit that the search required to properly examine any one of Group I, claims 114-137 of Group II, and Groups III-V and VII would necessarily involve an overlapping search for all of those Groups. Claims 114-137 of Group II depend from claim 52 of Group I. In addition, all of the claims in each of Groups III-V and VII, depend from claim 52. Therefore, each of the claims included in those Groups

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must necessarily include overlapping subject matter. As a result, any search of the claims of those Groups other than Group I would necessarily require a search of the same subject matter as would be required for a proper search of Group I. As a result, the Examiner has not shown that a serious burden would exist if all of these Groups were to be examined along with Group I. In fact, the Examiner has acknowledged that at least Groups III and IV would be classified in the same class and subclass, and therefore require a substantially common search. Consequently, the requirement for restriction between Groups I-V and VII is improper, and it is respectfully requested that the Examiner reconsider and withdraw it.

For at least the reasons mentioned above, Applicants respectfully request that the Examiner modify the restriction requirement so that Applicants will be able to elect between either 1) Group I, claims 114-137 of Group II, and Groups III-V and VII, together, or 2) claims 106-113 of Group II and Groups VI and VIII, together. If the Examiner agrees to this modification, Applicants provisionally elect to prosecute Group I, claims 114-137 of Group II, and Groups III-V and VII, i.e., claims 1-105, 114-187, and 200-212. If, on the other hand, the Examiner insists on maintaining the entire restriction requirement and refuses to modify it as suggested, Applicants provisionally elect Group I, claims 1-105, with traverse, and respectfully request that the Examiner make the restriction requirement final as soon as possible so that Applicants will have an opportunity to file a petition requesting the Group Director to review the restriction requirement. Further, in the event that claim 52 is deemed allowable, Applicants respectfully request that claims 114-137 of Group II, along with the claims of Groups III-V and VII be rejoined and allowed by virtue of their dependency on claim 52.

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Applicants respectfully note that the Office Action contains numerous characterizations of inventions and claims with which Applicants do not necessarily agree. Unless expressly noted otherwise herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

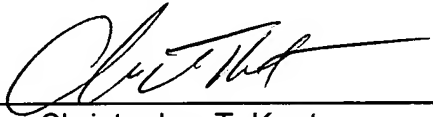
The Examiner is invited to call Applicants' undersigned representative at 571-203-2739 if a telephone conversation would clarify this traversal of the restriction requirement or otherwise expedite the prosecution of the above-referenced application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 30, 2003

By: 
Christopher T. Kent
Reg. No. 48,216

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